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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,073	04/19/2000	Adam Coyle	06042-0145	3058

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MORRIS MANNING & MARTIN LLP
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE ROAD, NE
ATLANTA, GA 30326-1044

EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/552073

Applicant(s)

Norton

Examiner

Akers, J

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/12/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-157 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Request for Continued Examination(RCE)

1. This action is issued in reply to applicant's Request for Continued Examination(RCE)(Paper #13) and Amendment(Paper # 14) both filed 9/12/03.
2. All original claims 1-25 were canceled.New claims 26-157 were entered.
3. New claims 26-157 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-157 are rejected under 35 USC 103(a) as unpatentable over Downing(US Pat. No: 5,963,647) in view of Gustin(US Pat. No:5,897,625) in view of First Data Corporation(1996) and further in view of Jennings(5,825,03).
6. As per claims 26-157 Downing teaches a method of issuing a negotiable instrument to an individual comprising detecting a direct deposit of funds into an first account of an individual and maintained by a first entity and transferring the funds unto a second account (Abstract)(Fig 5A).Downing teaches detecting the direct deposit of funds into the first account and detecting a credit in the first account and wherein automatically transferring the total amount of the funds for

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direct deposit of funds into the into the second account comprises posting a debit in the first account and a credit in the second account(Fig 5B/S11)(Fig 6A/S115)(col 10 line 64-col 12 line 5).Downing also teaches wherein determining the value of the requested negotiable instrument is not in excess of the balance of the second account comprises receiving an account number and a PIN number(col 6 lines 9-34) and determing that the account number identifies the second account(col 6 lines 59-65) and determining that the PIN number identifies the individual as being authorized to access the account(col 6 lines 18-21) and comparing the value of the requested negotiable instrument to the balance in the second account(col 6 lines 47-53). Downing also teaching a POS terminal(CAT)(Fig 2/6/12). Downing teaches cashing the negotiable instrument(col 5 lines 34-46)(col 7 lines 22-28) and determing that the account number identifies the second account(col 6 lines 59-65) providing the requisite anonymity.Downing teaches an ATM machine(Fig 2/6/12) for operations and authorization(Fig 3/30) and assessed fees(Fig 4/47) as well asa terminal ID(Fig 4/51) and a transfer amount(Fig 4/46) as well as processing other transactions (Fig 5A) and debiting the source account for fees(Fig 5C/S21) and displaying available funds(Fig 6A/S114) and debiting the source account in the amount of the withdrawal through electronic funds transfer(Fig 6B/S119).Downing does not specifically teach detecting a request by an individual for the issuance of a requested negotiable instrument having a value. Gustin teaches this(Abstract)(col 3 line 65-col 5 line 12)as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 11A) and authorizing the issuance of the requested negotiable instrument(Fig 18A) and debiting the second

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account by the amount of the instrument(Fig 18B).Gustin further teaches purchasing a money order(Fig 18A) and printing it(Fig 18B/620)(Fig 18D) and payment by credit card(Fig 18B/612) or smart card(Fig 18B/614).Gustin further teaches cashing a money order(Fig 17/580) and dispensing cash(Fig 17/584). Gustin also teaches wiring money(Fig 19) and a routing code number(Fig 19B) and an account number(Fig 19D) as well as prepaid cards(Fig 21)(Fig 21A)(Fig 21B) which are negotiable instruments.It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Gustin to teach the above. The motivation to combine is to teach a method of transferring funds for customers in an ATM-like machine for buying money ordersa and transferring funds as enunciated by Gustin(col 3 lines 56-63).In addition to that taught by Gustin, First Data Corporation through its subsidiary Western Union Financial Services, and Telecheck(Page 1)also teaches automatic sweeping of funds into a second account from a first account with no individual name.It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Gustin and further in view of First Data to teach part of the disclosure.The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by First Data.Downing also does not specifically teach wherein the first entity is subject to federal banking regulations and wherein the second entity is not. Jennings teaches this(col 2 lines 37-56)(Fig 6/212/214/216/218).Downing also does not specifically teach wherein the first entity is a bank and wherein the second entity is a licensed money transmitter. Jennings teaches this(Abstract)(Fig 1)(Fig 5)(Fig 7).Downing does not specifically teach determining the value of

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the requested negotiable instrument is not in excess of the balance of the second account comprises determining that the value of the requested negotiable instrument plus any fees charged to the individual is not in excess of the balance of the second account. Jennings teaches this(Fig 13/818) as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 12) and authorizing the issuance of the requested negotiable instrument(Fig 14) and debiting the second account by the amount of the instrument(Fig 6).Downing does not specifically teach wherein determining that the aggregate value of the requested multiple negotiable instruments is not in excess of the balance of the second account and comprises determining that the aggregate value of the requested multiple negotiable instruments plus any fees charged to the individual that is not in excess of the balance of the second account.Jennings teaches this(Fig 12/722/726/738/734)as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 13/822/828/824) and authorizing the issuance of the requested negotiable instrument(Fig 14) and debiting the second account by the amount of the instrument(Fig 6/222/224).Jennings further teaches a dispensing mechanism(Fig 3/44) and transfer currency and source accounts(Fig 6/222) and destinations(Fig 10/602) and check for not sufficient funds(Fig 13-1/818) and limit exceeded flags(Fig 13-1/824) and minimum balance exceed(Fig 13-2/834) and transfer amounts too large(Fig 14/760).Jennings further teaches an account number(Fig 9)(Fig 6/218) and a PIN(Fig 6/202). It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Gustin in view of First Data and further in view of Jennings to

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teach the disclosure. The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).

Response to Arguments

7. Applicant's arguments with respect to new claims 26-157 have been considered but are moot in view of the necessitated additional ground(s) of rejection.

Conclusion

8. THIS ACTION IS MADE NON-FINAL.

9. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA

November 14, 2003

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER